

### Remarks

The present amendment is made in response to the Office Action dated August 9, 2007, and identified as Paper No. 20070801. Claims 13-20 are pending in the present application.

In the Action, the Examiner rejected claims 13-18 under 35 U.S.C. 103(a) as being obvious over U.S. Patent Application Publication No. 2002/0065682 to Goldenberg (*Goldenberg*) in view of U.S. Patent Application Publication No. 2001/0032099 to Joao (*Joao*), and claims 19-21 under 35 U.S.C. 103(a) as being unpatentable over *Goldenberg* in view of *Joao*, in further view of U.S. Patent No. 6,505,166 to Stephanou (*Stephanou*).

#### **I. Rejections under 35 U.S.C. § 103 in view of *Goldenberg* and *Joao***

According to the Examiner, it would have been obvious to one of skill in the art to combine *Goldenberg* and *Joao* “to process healthcare claims.” This combination is improper and fails to present a prima facie case of obviousness for several reasons.

First, the simple substitution of the payor from Joao for the patient of *Goldenberg* does not form the claimed invention. As explained in a prior reply, *Goldenberg* fails to disclose several of the claimed steps of present invention – not just that the method is for a payor. In particular, *Goldenberg* does not provide for the transmittal of information from any database (payor or patient) to a physician in response to an inquiry. In the portion of the specification identified by the Examiner as disclosing this element, *Goldenberg* generally discloses a database but does not disclose transmitting information from a client database to a physician in response to an inquiry. Thus, *Goldenberg* fails to disclose both limitations, namely transmitting information from a client database **and** transmitting that information in response to a physician inquiry. The Examiner failed to explain how *Joao* supplements this shortcoming, which it does not.

In addition, the claimed invention recites “tracking said request [the request for the referral] to ensure that the medical services are provided.” *Goldenberg* only provides for selecting another physician if the first selected physician cannot provide the services. Selecting another physician is not “ensuring the services are actually provided” as there is no way to know whether the second physician actually performs the services. *Goldenberg* simply lets a patient *select* another available physician, and does not *ensure* or *verify* that the services are in fact performed. These are two very different things, and *Joao* fails to supply this missing element.

Second, the Examiner’s proposed motivation is insufficient to support the proposed combination. In particular, the Examiner’s reasoning that *Goldenberg* should be completely reconstructed to be a payor-based system because such a change would be helpful “to process healthcare claims” is overly simplistic and incapable of supporting the vast number of technical changes necessary to *Goldenberg*. The Examiner failed to show how such changes should or could be implemented. *See* MPEP 2143.01 (“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art”). In fact, the changes proposed by the Examiner would not even fulfill the stated objective of fulfilling healthcare claims as the resulting system would not be capable of processing such claims. Thus, the proposed motivation does not truly motivate the combination specifically claimed by the applicant, just the general idea of a system for a payor. MPEP § 2143.01.

Finally, and most importantly, the Examiner’s proposed combination is legally improper because it changes the principle operation of *Goldenberg*. According to the MPEP § 2143.01(VI), “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the

references are not sufficient to render the claims *prima facie* obvious.” The Examiner’s proposed changes completely alter the operation of the primary reference from a patient referral system and convert it into a healthcare claim processing system. As a result, the proposed modifications are improper under MPEP 2143.01 and cannot support an obviousness rejection.

## **II. Rejections under 35 U.S.C. § 103 in view of *Goldenberg*, *Joao*, and *Stephanou***

According to the Examiner, one of ordinary skill in the art would further modify the combination of *Goldenberg* and *Joao* according to *Stephanou* to include the further step of recruiting a physician to provide a help desk that would “competently answer questions in response to queries for help from customers.” This proposed motivation is completely irrelevant to the proposed changes. The invention recited in claims 19-21 requires the steps of recruiting physicians to participate in the referral system, providing independent review of referrals, and tracking success and costs. None of these claimed steps were identified in any of the prior art, nor do these claimed steps have anything to do with providing a “help desk.” The Examiner failed to properly identify where each of the claimed steps are found in the claimed combination, and therefore failed to present a *prima facie* case of obviousness. Even if these steps were in the prior art, the proposed motivation is completely irrelevant to the inclusion of the steps in the claimed method.

Authorization to charge the fee associated with a three month extension of the reply period is submitted herewith.

In view of the foregoing, the Examiner’s reconsideration and allowance of the claims of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant’s attorney would expedite prosecution of this application, please contact the undersigned at (315) 218-8530.

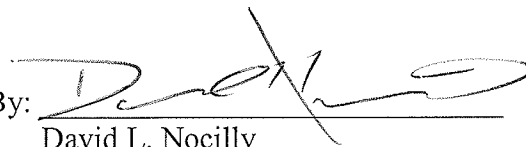
Reply to Office Action dated February 11, 2008  
Application Serial No. 10/035,970  
Amendment dated February 11, 2008

Respectfully submitted,

Philip J. Passantino

Date: February 11, 2008

By:

A handwritten signature in black ink, appearing to read "D. Nocilly", written over a horizontal line.

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